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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,008	04/13/2004	Dana Eagles	930007-2166.A	4697
20999	7590	01/24/2006	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			VASUDEVA, AJAY	
			ART UNIT	PAPER NUMBER
			3617	

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/823,008

Applicant(s)

EAGLES ET AL.

Examiner

Ajay Vasudeva

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29,32-36,44 and 47-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29 and 36 is/are allowed.
- 6) ☒ Claim(s) 33,35,44 and 47-55 is/are rejected.
- 7) ☒ Claim(s) 32 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 44 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawthorne et al. (US 2,997,973) in view of Shimozono et al. (US 6,021,915).

Hawthorne shows a vessel for storing liquids, the vessel being utilized for through water transportation of cargo. Hawthorne discloses the elements of claim 44, and discloses weaving.

Hawthorne, however, does not disclose warp and weft fibers or yarns.

Shimozono shows a flexible fabric tubular vessel for holding fluid. The tube is woven using warp and weft yarns. Such is well known and common. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawthorne by using warp and weft yarns in the weave of the tubular structure. The motivation would be to use weaving techniques that are well known in the art.

The limitation "for through water transportation of cargo" (emphasis added) in the preamble is merely an intended use limitation and has not been accorded any patentable weight.

Re claim 44, it is noted that the recitation "wherein the tapered end is woven by gradually eliminating ... during weaving" is a product by process limitation. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Even though product-by-process claims are limited by and

Art Unit: 3617

defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. See MPEP 2113. Hawthorne in view of Shimozono discloses the structure.

3. Claims 47-50, 54, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawthorne et al. (US 2,997,973) in view of Fowler et al. (US 4,055,201).

Regarding claim 54, Hawthorne shows a vessel comprising a tubular structure (1) that is: elongate, flexible, made of fabric, impervious, and has front and rear sealed ends. The vessel comprises a pipe for filling and emptying cargo. The vessel is woven in one piece as a continuous tube. The front end (2) is tapered to a circumference that is less than the circumference of the central portion. The rear end (10) is also tapered to a circumference that is less than the circumference of the central portion. Hawthorne discloses weaving.

Hawthorne, however, does not disclose knitting and braiding.

Fowler shows a flexible tubular structure for holding fluids. The tubular structure is made of fabric and can be woven, braided, or knitted. Thus Fowler shows the equivalence of a woven, braided, or knitted fabric tubular vessel. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawthorne by making the tubular vessel a knitted tubular vessel or a braided tubular vessel. The motivation would be to make and use the vessel using fabrics that are well known in the art.

Regarding claims 47 and 48, Fowler discloses knitting or braiding. It would have been obvious to use knitting based upon Fowlers disclosure.

Further regarding claim 47, it is noted that the recitation "**formed by gradually dropping ... of said tapered end to create the taper**" is a product by process

Art Unit: 3617

limitation. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. See MPEP 2113.

Hawthorne in view of Fowler discloses the structure.

Regarding claims 49 and 50, Fowler discloses knitting or braiding. It would have been obvious to use knitting based upon Fowlers disclosure.

Further regarding claim 49, it is noted that the recitation "formed by adjusting the speed ... that is being braided" is a product by process limitation. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. See MPEP 2113. Hawthorne in view of Fowler discloses the structure.

Regarding claim 55, Hawthorne shows that both the front and rear ends have tapers.

4. Claims 33, 35, 52, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawthorne et al. (US 2,997,973) in view of Fowler et al. (US 4,055,201).

Hawthorne in view of Fowler, as described above with respect to claims 47-50, 54, and 55, discloses the knitted or braided structure with tapered ends.

Hawthorne in view of Fowler does not explicitly disclose the recited method steps.

The method steps, however, are inherent in the making and use of the modified Hawthorne apparatus. Therefore it would have been obvious to one having ordinary skill in the

Art Unit: 3617

art at the time the invention was made to devise the recited method steps. The motivation would be to make and use the modified Hawthorne apparatus.

Allowable Subject Matter

5. Claims 29 and 36 are allowed.
6. Claims 32 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed 10/13/2005 have been fully considered but they are not persuasive.

Applicant argues that Shimozono and Fowler are nonanalogous art for at least the following reasons:

- (i) The addition of limitation "for through water transportation of cargo" (emphasis added) makes Shimozono and Fowler non-analogous art because neither are used to transport a fluid contained therein through water. In contrast, Shimozono shows foldable water tanks used to hold water, while Fowler shows small fluid dispensing container.
- (ii) Shimozono and Fowler are classified in classes that are different from the classification of the Hawthorne reference.
- (iii) Shimozono and Fowler are not reasonably pertinent to the particular problem addressed by the instant invention, which is the through water transportation of fluids. The

Art Unit: 3617

structures of Shimozono and Fowler not only small, but are not designed to be towed through the water.

Response to arguments:

The use of limitation "for through water transportation of cargo" (emphasis added) is merely an intended use limitation, and therefore has not been accorded any patentable weight in the claims. Even if the Hawthorne reference had failed to show a through water transportation, such could still be applied for a rejection.

The Shimozono and Fowler references are considered analogous to the Hawthorne reference because all show fabric containers for holding fluids, and address the problem pertaining to the construction of such fabric containers.

Shimozono discloses a "water tank which has a cylindrical shape and which is composed of a specified woven cloth" (see Shimozono, column 1, lines 25-30). Shimozono claims "[a] foldable water tank ... made from ... a woven cloth sheet" (see Shimozono, claim 2). That is a fabric container for holding fluid. Fowler discloses "nonaerosol fluid dispensing containers and more particularly to an expansible fabric for providing the force which dispenses the fluid from the container" (see Fowler, column 1, lines 13-16). Fowler claims "[a]n expansible fabric suitable for disposition about a fluid containing expansible member" (see Fowler, claim 1). That is a fabric container that holds a liquid within its enclosed volume. Both Shimozono and Fowler disclose details of how the fabric containers are constructed. Thus both Shimozono and Fowler are within applicant's field of endeavor or alternatively address the same problem as applicant. Therefore Shimozono and Fowler are analogous art and applicant's argument is not persuasive.

Art Unit: 3617

Alternatively, if applicant's field of endeavor and problem to be solved are determined from applicant's disclosure, then applicant's argument still fails. It is asserted that applicant's invention is essentially a very large fabric container for holding and transporting water, and that the problem to be solved is how to construct the fabric container.

In attempting to distinguish his invention from Shimozono and Fowler, applicant characterizes his invention as "large", "very large", with "a length of 300 feet or more and a diameter of 40 feet or more" and uses phrases including "for the ocean transportation", "with ocean transportation", and "towed through the ocean". Applicant is correct that Shimozono and Fowler disclose much smaller articles. But scale is generally easily modified by the skilled artisan. It is asserted that Shimozono and Fowler disclose essentially the same structure -- a fabric container for holding water -- although on a much smaller scale. Thus they are in the same field of endeavor because they address the same problem despite their smaller size -- i.e., how to construct a fabric container for holding water.

Applicant does not positively recite towing, or ocean going, or any specific length or diameter. As such, it is the examiner's position that the invention, as claimed, pertains to the construction of a fabric container for holding and/or storing fluid. Thus the field of endeavor is making a fabric container for holding and transporting fluid. And the particular problem with which the inventor is concerned is how to construct the fabric container with tapered ends. (Applicant does use the word "large" in the preamble of each independent claim. The term "large" however is relative. A centimeter is large compared to a micrometer. Thus anything that is bigger than something else is large.)

As for the arguments regarding the classification, it is noted that the primary class of a patent is assigned based on the subject matter claimed, and not necessarily based on what has been disclosed in the specification. There is no requirement that references have to be

Art Unit: 3617

classified in the same or similar classes to be considered analogous. Therefore, such argument is considered flawed.

Therefore, Hawthorne, Shimozone, Fowler are all analogous art and applicant's argument is not persuasive.

Conclusion

8. This Office action is a non-final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay Vasudeva whose telephone number is (571) 272-6689. The examiner can normally be reached on Monday-Friday 12:00 -- 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ajay Vasudeva
Examiner
Art Unit 3617

Ajay Vasudeva
AJAY VASUDEVA 1/19/06
PATENT EXAMINER